

**REMARKS**

The Office Action mailed June 13, 2006 has been carefully considered. Within the office action, Claims 1-7, 11 and 12 have been rejected. The Applicants have amended Claims 1 and 12 and have canceled Claim 11. The Applicants reserve the right to further pursue the cancelled claim in a continuation and/or divisional application as well as for appeal purposes. In addition, the Applicants have added new Claim 13. Reconsideration in view of the following remarks is respectfully requested. A three month Extension Fee is included with this response.

**The 35 U.S.C. § 112, Second Paragraph Rejection**

Within the Office Action, Claim 11 stands rejected under 35 U.S.C. 112, Second Paragraph as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Applicants respectfully traverse however to expedite to prosecution of the present application, the Applicants have cancelled Claim 11. Accordingly the rejection is now moot and should be withdrawn.

**Rejection under 35 U.S.C. § 103**

35 U.S.C. § 103(a) Claims 1-7, 11 and 12 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 5,261,840 to Benz (hereinafter referred to as "Benz"). The Applicants respectfully traverse.

Specifically, the Examiner states in the Office Action that Benz discloses the process recited in Claim 1 for the exception of forming the pleats on the edge strips. It is stated in the Office Action that Column 2, lines 3-22 in Benz indicates that it was known in the art at the time of the invention to make edge strips wavy and/or meander-shaped which allegedly is equivalent to pleats as recited in Claim 1. The Examiner admits that Benz indicates that the use of such a

feature is not preferred due to economic considerations. However, it is argued in the Office Action that one skilled in the art reviewing Benz or the prior art mentioned in Benz would find it obvious to include pleats as claimed in Claim 1. The Applicants respectfully disagree.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

See M.P.E.P. 2141.

The Applicants' Specification recites that the metal plating operation is carried out at the beginning of the fabrication method of the contact strip to reduce cost in terms of labor as well as the cost of not having to reinstall just the ribbon between operations. (Applicants' Specification, Paragraph 0026). In addition, Applicants' Specification specifically states that the pleats are formed in the continuous edge strips ES1 and ES2 of the ribbon *before* the contact strip undergoes the hardening heat treatment process. (Applicants' Specification, Paragraph 0026). Applicants' specification states that the use of the pleats are important to reduce the pitch dimension and thereby allow the blades to be closer to and overlap one another to produce a higher density contact strip. Applicants' specification specifically states that the pleating operation must take place *after* the metal plating of the ribbon to avoid poor plating in the mutually overlapping portions of the blade and prevent the edge strips ES1 And ES2 from breaking when being pleated. (Applicants' Specification, Paragraphs 0029 & 0040).

Amended Claim 1 recites, among other things, that the ribbon is metal-plated to cover both sides and then is fabricated to have openings formed therein. Claim 1 also recites that the

blades which are formed as a result of the openings are twisted and bent. Claim 1 further recites that the continuous edge strips are pleated *after* the ribbon is metal plated. In addition, Claim 1 recites that the contact strip is hardened using the heat treatment *after* the two continuous edges strips are pleated.

In contrast, Benz does not provide the requisite motivation to one skilled in the art to modify Benz or combine Benz with another reference to reach the subject matter in Claim 1. Although the background section of Benz states that the contact elements may have edge strips which are wavy or meander-shaped, Benz specifically teaches away from using pleats. In particular, Benz states that wavy or meandering shaped edge strips are likely to break after hardening due to their very small radii of curvature. (Benz, Col. 2, Lines 8-11). Benz goes on to state that the danger of breakage can be reduced by making the edge strips flexible again after hardening of the heat treatment; however this requires additional operation which makes production of contact elements more expensive than non-wavy edge strips. (Benz, Col. 2, Lines 12-18). In addition, Benz discloses that plating is performed on the contact strip *after* the strip is punched and *after* the hardening heat treatment is applied. This is notwithstanding that Benz does not even disclose using pleats in its structure and that the only mention of pleats are in terms of the disadvantages of using them in the Benz's background section.

Benz must be taken as a whole and cannot be taken piecemeal to show the requisite motivation needed to establish a prima facie case of obviousness. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983) (when considering the whole prior art reference its entirety, portions that would lead away from the claimed invention must be considered.); See M.P.E.P. 2141.02. As stated above, Benz specifically states in its background the disadvantages of using pleats and how they cause failure in the contact strips. This information taken with the fact that the contract strip in Benz does not incorporate any sort of pleat design would lead one

skilled in the art not to modify the process in Benz to form pleats in the contact strip or to combine Benz with another reference which contains pleats in reaching the subject matter claimed in Claim 1.

Even if one skilled in the art would incorporate a pleating process with the process in Column 9 of Benz, there would not be a reasonable expectation of success. Benz specifically describes that the plating process occurs as the last step after the hardening heat treatment step. For arguments sake, if one skilled in the art reviewing Benz would include a pleating process after the heat treatment step and before the plating process, this would result in poor plating in the mutually overlapping portions of the blade. On the other hand, if one skilled in the art reviewing Benz would include a pleating process after both the heat treatment and plating process, this would result in possible breakage of the pleats in the contact strip. In other words, for one skilled in the art reading Benz (without the benefit of Applicants' disclosure or any hint teaching or suggestion in Benz's specification) to make a successful contact strip, he would have to reorder the steps to place the plating process from the last step to the first step and include a non-disclosed pleating process before the heat treatment process. This just does not result in the requisite motivation needed to prove obviousness. Accordingly, one skilled in the art would not find the motivation to combine or modify Benz to reach the subject matter in Claim 1. For at least these reasons, one skilled in the art would not find the embodiment in Claim 1 to be obvious in light of Benz. Therefore, the Applicants respectfully requests allowance of Claim 1.

Claims 2-7, and 12 have also been rejected in light of Benz. However, Claims 2-7 and 12 are dependent on Independent Claim 1. As stated above, Claim 1 is allowable over Benz. Accordingly, Claims 2-7 and 12 are allowable for being dependent on an allowable base claim.

New Claim

The Applicants have added new Claim 13 to the present application, it should be noted that the new Claim 13 is fully supported by this specification and that no new matter has been added. Allowance of new Claim 13 is respectfully requested.

Conclusion

It is believed that this Response places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698. A three month Extension Fee is included herewith.

Respectfully submitted,  
THELEN REID BROWN RAYSMAN & STEINER LLP

A handwritten signature in black ink, appearing to read 'S. Bhattacharya', written over a horizontal line.

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